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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,052	01/29/2004	Ricky D. Morgan	02-2-210DIV1	4813

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OSRAM SYLVANIA INC
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DANVERS, MA 01923

EXAMINER

SHEEHAN, JOHN P

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 12/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/767,052

Applicant(s)

MORGAN ET AL.

Examiner

John P. Sheehan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 8-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

I. The first paragraph of the specification is objected to in that the status of the parent application is not up to date. Parent application 10/160,751 has issued as US Patent 6,830,637. The specification should be amended to reflect this.

Appropriate correction is required.

Claim Interpretation

2. The claims are directed to a method of making a "a large-diameter tungsten-lanthana rod". The term "large diameter" is defined in the specification (page 3, lines 14 to 16):

"As used herein, large diameter means
that the rod has a diameter greater
than 0.625 inches as worked."

3. However, since the phrase, "a large-diameter tungsten-lanthana rod" appears as part of the preamble it is given little, if any, weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are

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able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8 to 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anders (US Patent No. 3,159,908).

Anders teaches a method of making a dispersion hardened metal product containing oxides dispersed throughout, wherein the metal can be tungsten and the oxide can be lanthana (lanthanum oxide) (column 2, lines 52 to column 3, lines 15) as recited in each of applicants' claim. Anders' process of making the tungsten-lanthana product includes the steps of hot rolling (column 4, lines 67 to 69) the tungsten-lanthana work piece at a temperature of not higher than $\frac{1}{2}$ the melting point of the metal (column 4, lines 32 to 42) at a reduction rate of 45 to 95% (column 4, lines 54 to 56) and annealing, i.e., stress relief annealing, the hot rolled work piece (column 5, lines 21 to 29). Anders' reduction rate overlaps the reduction rate recited in applicants' claims. Anders' tungsten-lanthana workpiece contains 0.1 to 10.0 % oxide (column 3, lines 29 to 32) which is encompassed by applicants' claim 8 to 11, 13 and 14 and overlaps the oxide content of claim 12.

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The Condensed Chemical dictionary teaches that tungsten metal has a melting point of 3410⁰C.

The claims and Anders differ in that Anders does not teach the hot working temperature recited in applicants' claim 8, the exact reduction rate nor the properties recited in claim 11.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because Anders teaches a working temperature of up to ½ the melting point of tungsten. In view of the fact that the Condensed Chemical Dictionary teaches that the melting point of tungsten is 3410⁰C, this means that Anders teaches a working temperature of up to 1705⁰C which overlaps the claimed working temperature of 1400 to less than 1700⁰C. Further, Anders reduction rate overlaps the reduction rate recited in applicants' claims. Thus, the fact that Anders reduction rate and working temperature both overlap the values recited in applicants' claims establishes a prima facie of obviousness because a prima facie case of obviousness exists when the ranges of a claimed invention overlap the ranges disclosed in the prior art In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

Regarding the properties recited in claim 11, in view of the fact that the product taught by the reference is made by a process which is similar to, if not the same as, applicants' process of making the instantly claimed alloy, the alloy taught by the

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reference would be expected to possess all the same properties as recited in the instant claim 11, In re Best, 195 USPQ, 430 and MPEP 2112.01.

"Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, In re Best, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' In re Spada, 15 USPQ2d 655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 195 USPQ 430, 433 (CCPA 1977)." see MPEP 2112.01.

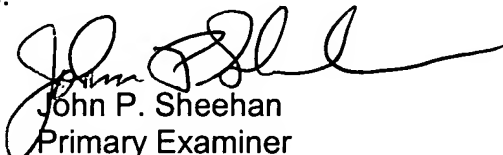
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571) 272-1249. The examiner can normally be reached on T-F (6:45-4:30) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Sheehan
Primary Examiner
Art Unit 1742

jps